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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,675	07/09/2001	Nicholas Paul Elliott	UDL 2 0011	2251

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ARLINGTON, VA 22203

EXAMINER
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KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/807,675

Applicant(s)

ELLIOTT ET AL.

Examiner

Paula W. Klimach

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/27/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed on 7/20/06. The amendment filed on 7/20/06 have been entered and made of record. Therefore, presently pending claims are 1-10 and 15-17.

### ***Response to Arguments***

Applicant's arguments filed 7/20/06 have been fully considered and have been found persuasive. The rejection using newly cited art is provided below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 7-8 and 10** are rejected under 35 U.S.C. 102(e) as being anticipated by Doljack (6,442,276).

*In reference to claim 7*, Doljack discloses a method for verifying the authenticity of goods (Abstract). The method includes applying public data to the goods for use in a subsequent verification process (column 8 line 40-67), and applying a security code to the goods (column 8 line 40-67), said security code having been derived by means of a predetermined encryption

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algorithm by encrypting said public data applied to the goods and one of a plurality of private data sets held by a verifier (column 8 lines 15-61).

*In reference to claim 8* wherein the public data includes a batch number (column 5 line 67 to column 6 line 5 in combination with column 8 lines 15-20). The products as suggested in claim 1 are made in large number and therefore the random number for the product is the batch number.

*In reference to claim 10* Doljack discloses a system wherein said public data and security code is incorporated into the design printed onto the goods as reversed out characters, blends or tints (Fig. 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 9** is rejected 35 U.S.C. 103(a) as being unpatentable over Doljack (6,442,276B1).

*In reference to claim 9*, wherein the public data includes date information.

Although Doljack discloses examples of data that may be added to the public data, Doljack does not expressly disclose including data information.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add date information to the code in the system of Doljack. One of ordinary skill

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in the art would have been motivated to do this because the date may be used to determine the time period that the data was valid and therefore reduce counterfeiting.

**Claims 1, 3-6, and 15-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Doljack (6,442,276 B1) in view of Moore (5,895,073).

*In reference to claims 1, 15-17*, Doljack discloses a method for verifying the authenticity of goods (Abstract). The method includes generating a list of verification codes (Figure 4), each of said verification codes being generated by said predetermined encryption algorithm by encrypting said public data and one of said plurality of private data sets (column 8 lines 15-50), wherein the private data sets are held by a verifier (column 8 lines 28). The system is finally used to comparing said security code applied to the goods with said list of verification codes to assess the authenticity of goods (Fig. 3).

The system of Doljack does not expressly disclose sending a request for verification although the system does indicate the local computer is used to read the code and send it off for verification.

Moore discloses a system and method of marking goods for authentication (abstract). The method includes receiving a request for verification (column 5 lines 15-19 in combination with column 9 lines 15-21). Downloading the value is a request for verification.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to send a request to verify the product as in Moore in the system of Doljack. One of ordinary skill in the art would have been motivated to do this because it would enable the system to be a distributed system and therefore spread the information necessary for the system

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to other system that are not necessarily in the same location which makes a cheaper system by being able to share central systems.

*In reference to claim 3* wherein the public data includes a batch number (column 5 line 67 to column 6 line 5 in combination with column 8 lines 15-20). The products as suggested in claim 1 are made in large number and therefore the random number for the product is the batch number.

*In reference to claim 4*, wherein the public data includes date information.

Although Doljack discloses examples of data that may be added to the public data, Doljack does not expressly disclose including data information.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add date information to the code in the system of Doljack. One of ordinary skill in the art would have been motivated to do this because the date may be used to determine the time period that the data was valid and therefore reduce counterfeiting.

*In reference to claim 5*, wherein the private data includes an item number.

Although Doljack discloses examples of data that may be added to the public data, Doljack does not expressly disclose including the item number.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to add item number to the code in the system of Doljack. One of ordinary skill in the art would have been motivated to do this because the date may be used to determine the time period that the data was valid and therefore reduce counterfeiting.

*In reference to claim 6* Doljack discloses a system wherein said public data and security code is incorporated into the design printed onto the goods as reversed out characters, blends or tints (Fig. 1).

**Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Doljack in view of Moore as applied to claim 1 above, and further in view of Tran (5,864,665).

Doljack does not disclose a system wherein the verifier maintains a log of requests for verification and, upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

Tran discloses a method of auditing login activity (abstract), where login activity is used to verify that users are who they say they are, by maintaining a record of valid login (column 7 lines 54-60 and column 8 lines 44-47). This information may generally used for verification upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to maintain a log of verification requests as in Tran in the system of Doljack. One of ordinary skill in the art would have been motivated to do this because the log would provide a record of the goods needing verification.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854.

The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK  
Friday, September 29, 2006

  
HOSUK SONG  
PRIMARY EXAMINER